REMARKS

By virtue of this response, Claims 1-6 and 9-21 are currently pending in the application. Claims 1-6 and 10 have been withdrawn. Claims 7 and 8 have been cancelled. Claims 9 and 16 have been amended. These changes do not introduce new matter and entry of the amendment is respectfully requested.

Claim Rejections under 35 U.S.C.§112, second paragraph

Claims 9 and 11-21 stand rejected under 35 U.S.C. §112, second paragraph, as indefinite in recitation of the terms "PRL-TRE" (Claim 9); "IRES" (Claim 16); and "derived from" (Claim 9).

Applicant respectfully disagrees, but have amended the claims herein to spell out the terms "PRL-TRE" (Claim 9) and "IRES" (Claim 16) in order to expedite prosecution of the case. The term "PRL-TRE" means prenylated protein tyrosine phosphatase 3 gene (PRL-3) transcriptional response element (TRE). The basis for prenylated protein tyrosine phosphatase is GenBank Accession No., recited on page 3, paragraph 12 and the basis for transcriptional response element is found at least on page 7, paragraph 30 of the specification. The basis for internal ribosome entry site (IRES) is found at least on page 3, paragraph 9 of the specification.

Claim 9 has been amended herein to further clarify the term "derived from". The current language reflects the description in paragraph 102 of the specification which states that the PRL-TRE sequence is obtained from the 0.6kb sequence upstream of the translational start codon for the PRL-3 gene and has the transcriptional regulatory factor activity of the PRL-3 TRE sequence presented herein as SEQ ID NO:1.

Applicants respectfully submit that the grounds for the rejection have been obviated by the amendments submitted herein. Withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Claim Rejections under 35 U.S.C.§112, first paragraph

Claims 7-9 and 11-21 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

The Office Action maintains that the specification while enabling for the PRL-3 gene sequence presented as SEQ ID NO:1 does not reasonable provide enablement for uses of the various tPRL-3 gene sequences derived from SEQ ID NO:1.

The first paragraph of 35 U.S.C. § 112 requires that the specification of a patent enable any person skilled in the art to which it pertains to make and use the claimed invention. Although the statute does not say so, enablement requires that the specification teach those in the art to make and use the invention without undue experimentation (e.g., In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir., 1991). An invention is enabled even though the disclosure may require some routine experimentation to practice the invention. Hybritech Inc. V. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 U.S.P.Q. 81, 94 (Fed. Cir. 1986).

Without agreeing to the propriety of the rejection, in the interest of expediting prosecution of this case, Applicants have amended the claims herein to clarify that the claimed PRL-3 TRE is obtained from the 0.6kb sequence upstream of the translational start codon for the PRL-3 gene, and has the transcriptional regulatory factor activity of the PRL-3 TRE sequence presented herein as SEQ ID NO:1. Hence Applicant has provided both the structural and functional characteristics of the claimed PRL-3 TRE such that those of skill in the art can make and use the invention without undue experimentation.

In view of the above amendments and remarks, withdrawal of the enablement rejection under 35 U.S.C. § 112 is respectfully requested.

CONCLUSION

Applicants submit that the application is now in condition for examination on the merits. Early notification of such action is earnestly solicited. If any issues remain which the Examiner feels may be best resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact Applicants counsel, Linda R. Judge at (415) 836-2586.

Respectfully submitted,

Date: 12/22/06

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